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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,124	03/30/2001	Ellen M. Nelson	10003323-1	8877

7590 08/01/2005  
AGILENT TECHNOLOGIES, INC.  
Legal Department, 51U-PD  
Intellectual Property Administration  
P.O. Box 58043  
Santa Clara, CA 95052-8043

EXAMINER
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CARDONE, JASON D

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/822,124

Applicant(s)

NELSON ET AL.

Examiner

Jason D. Cardone

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/11/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. This action is responsive to the remarks of the applicants, filed on 5/11/05.

Claims 1-20 are presented for further examination.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed subject matter is a software product for a computer system but not actively being used on a computer. Therefore, claims 1-10 are not tangibly embodied.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-20 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-11 and 13-20 of copending Application No. 09/821,917. Although the conflicting claims are not identical, they are not patentably distinct from each other because they have the same subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Barrick, Jr. et al. ("Barrick"), USPN 6,006,260.

8. Regarding claim 1, Barrick discloses a software product for a computer system to configure a transaction for a user operating a web browser wherein the transaction is used for automated testing of an Internet server system, the software product comprising: test instructions configured direct a processor to interact with the web browser and the Internet server system to record web browser activity to generate the

transaction [Barrick, col. 2, lines 18-35 and col. 4, line 60 – col. 5, line 6]; edit the transaction [Barrick, col. 2, lines 18-53 and col. 8, line 27 – col. 9, line 45];

perform an automated test of the Internet server system using the transaction; display test results to the user from the automated test [Barrick, col. 2, lines 36-53 and col. 7, line 52 – col. 8, line 26];

save the transaction for subsequent automated testing of the Internet server system; and a storage medium configured to store the test instructions [Barrick, col. 2, lines 36-53 and col. 9, lines 28-45].

9. Regarding claim 2, Barrick further discloses the test instructions are further configured to direct the processor to interact with the web browser and the Internet server system through a firewall [Barrick, col. 5, lines 17-35].

10. Regarding claims 3 and 4, Barrick further discloses the test instructions are further configured to direct the processor to record the web browser activity to generate test measurements, wherein one of the test measurements is a sequence of web pages [Barrick, col. 2, lines 18-35 and col. 4, line 60 – col. 5, line 6].

11. Regarding claim 5, Barrick further discloses the test instructions are further configured to direct the processor to add test measurements to the transaction including transaction time and transaction data transfer rate [Barrick, col. 7, lines 9-67].

12. Regarding claim 6, Barrick further discloses the test instructions are further configured to direct the processor to record the browser activity as a series of steps and to edit the transaction to specify test measurements for each step [Barrick, col. 2, lines 36-53 and col. 7, line 52 – col. 8, line 26].

13. Regarding claims 7-9, Barrick further discloses one of the test measurements for each step is elapsed time, one of the test measurements for each step is a required string in an Internet server system response and one of the test measurements for each step is a prohibited string in an internet server system response [Barrick, col. 7, lines 9-67].

14. Regarding claim 10, Barrick further discloses the test instructions are further configured to direct the processor to record pauses for the steps and edit the transaction to redefine the pauses [Barrick, col. 8, line 27 – col. 9, line 45].

15. Regarding claims 11-20, claims 11-20 have similar limitations as claims 1-10. Therefore, the similar limitations are disclosed under Barrick for the same reasons set forth in the rejection of claims 1-10 [Supra 1-10].

### ***Response to Arguments***

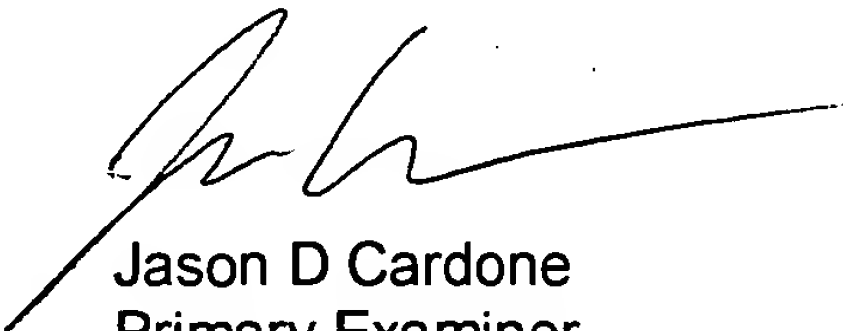
16. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone  
Primary Examiner  
Art Unit 2145

July 27, 2005